

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MANFRED LINK and WOLFGANG RUSS

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Appeal No. 1996-4079  
Application No. 08/239,916<sup>1</sup>

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ON REQUEST FOR REHEARING

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Before ABRAMS, FRANKFORT, and GONZALES, Administrative Patent Judges.<sup>2</sup>

GONZALES, Administrative Patent Judge.

ON REQUEST FOR REHEARING

The appellants request we reconsider our decision mailed

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<sup>1</sup> Application for patent filed May 9, 1994.

<sup>2</sup> Administrative Patent Judge Meister who was originally on this panel has retired and Administrative Patent Judge Abrams has been substituted in his place in this Appeal. See, In re Bose, 772 F.2d 866, 868, 227 USPQ 1, 2-3 (Fed. Cir. 1985).

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on March 24, 1999, wherein we affirmed the rejection of claims

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through 13 under 35 U.S.C. § 103 as being unpatentable over  
Kavanagh in view of Imai.

We have carefully reviewed the points of argument raised  
by appellants in their request, however, we note that instead  
of directing their request for rehearing to points which were  
misapprehended or overlooked in rendering the decision on  
appeal as is mandated by 37 CFR § 1.197(b), appellants have  
made new arguments not previously presented in their brief on  
appeal.

For the first time, appellants' request for rehearing  
argues that Kavanagh is not available as a prior art  
reference, because the reference is antedated by the May 7,  
1993 filing date of appellants' German application No.  
P4315142.6.<sup>3</sup> The request for rehearing is accompanied by an  
English language translation of the German language certified

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<sup>3</sup> The file shows that a claim for priority under 35 U.S.C. § 119 and 37  
CFR § 1.55 and a certified copy of the German application were filed on May 9,  
1994, the filing date of the present application (May 7, 1994 was a Saturday).

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copy and a declaration by a translator verifying that the translation is correct.<sup>4</sup>

The Kavanagh reference is a published British application and we were well aware of the correct publication date of the reference as well as appellants' claim for benefits under 35 U.S.C. § 119(a)-(d) and 37 CFR § 1.55(a) at the time of our decision. However, as a result of a typographical error, the publication date of the Kavanagh reference was identified in our decision as "Feb. 6, 1993," rather than June 2, 1993. The issue of appellants' entitlement to benefits under 35 U.S.C. § 119(a)-(d) and 37 CFR § 1.55(a) was not discussed in our earlier decision, because appellants never raised the issue in their brief, not because we misapprehended the publication date of the Kavanagh reference.

The file reveals that appellants were made aware of the

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<sup>4</sup> The request for rehearing actually states that the German document which was translated "is believed to contain the disclosure of the foreign priority application" (page 2). On June 10, 1999, a supplement to the request for rehearing was filed verifying the German document which was translated as a true copy of the certified copy filed on May 9, 1994.

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publication date of Kavanagh in the first Office action mailed June 27, 1994 (almost five (5) years prior to our decision), wherein the examiner correctly identified the effective date of the reference as June 1993, literally "6-1993," on Form PTO-892.

Yet, appellants delayed filing the English language translation

of the certified copy required by 37 CFR § 1.55(a) until after a decision was rendered on the merits of their appeal.<sup>5</sup> As a result of appellants failure to raise the issue of Kavanagh's availability as a reference or to supply the examiner with the

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<sup>5</sup> 37 CFR § 1.55(a) (1998) provides, in part, that:

If the certified copy is not in the English language, a translation need not be filed except in the case of interference; or when necessary to overcome the date of a reference relied upon by the examiner; or when specifically required by the examiner, in which event an English language translation must be filed together with a statement that the translation of the certified copy is accurate. (Emphasis added)

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English language translation of the certified copy prior to filing their appeal, the examiner was never provided the opportunity prior to our decision to determine if any of appellants' claims are, in fact, entitled to any benefit under 35 U.S.C. § 119(a)-(d) and 37 CFR § 1.55(a). Obviously, appellants' delay in filing the English translation required by 37 CFR § 1.55(a) was not caused by anything contained in our decision.

Appellants' attempt to belatedly present new arguments directed to the examiner's rejection of claims 1 through 13, is unavailing, since a new argument advanced in a request for

rehearing, but not advanced in appellants' brief, is not properly before the Board and will not be considered. See Ex parte Hindersinn, 177 USPQ 78, 80 (Bd. App. 1971) and Ex parte Harvey,

163 USPQ 572, 573 (Bd. App. 1968) (Question not presented to

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Board in appeal and not discussed by examiner is not appropriate for decision by Board on petition for reconsideration). Note also In re Kroekel, 803 F.2d 705, 708, 231 USPQ 640, 642 (Fed. Cir. 1986) and Cooper v. Goldfarb, 154 F.3d 1321, 1331, 47 USPQ2d 1896, 1904 (Fed. Cir. 1998) wherein the Court noted that a party cannot wait until after the Board has rendered an adverse decision and then present new arguments in a request for reconsideration.

The appellant's request is granted to the extent of reconsidering our decision, but is denied with respect to making any changes therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

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DENIED

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
	)	
	)	
	)	
JOHN F. GONZALES	)	
Administrative Patent Judge	)	

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